

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#8

Applicant : Judith F. Miller
Application No. : 09/911,620
Filed : July 24, 2001
Title : Hook and Loop System for Attaching a Breast Form
Prostheses to Garments with Built-In Cups

Group/A.U. : 3738
Examiner : Bruce Edward Snow
Docket No. : MILJ/101/US

Commissioner for Patents
United States Patent and
Trademark Office
Washington, DC 20231

ATTN: Board of Patent Appeals
and Interferences

Honorable Sir:

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BOARD OF PATENT APPEALS
AND INTERFERENCES

APPEAL BRIEF

This brief contains the following sections under the headings and in the order set forth below as required by (37 C.F.R. §1.192(c)):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS

V. SUMMARY OF THE INVENTION

VI. ISSUES

VII. GROUPING OF CLAIMS

VIII. ARGUMENTS - REJECTIONS UNDER 35 U.S.C. §102(b) (37 CFR §1.192(c)(8)(ii))

IX. ARGUMENTS - REJECTIONS UNDER 35 U.S.C. §103(a) (37 CFR §1.192(c)(8)(iv))

X. CONCLUSION

XI. APPENDIX OF CLAIMS INVOLVED IN APPEAL

I. REAL PARTY IN INTEREST (37 C.F.R. §1.192(c)(1))

The real party in interest is Judith F. Miller of East Hampton, Connecticut.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. §1.192(c)(2))

There are no known appeals or interferences related to this application.

III. STATUS OF CLAIMS (37 C.F.R. §1.192(c)(3))

a. TOTAL NUMBER OF CLAIMS IN THIS APPLICATION

CLAIMS IN THIS APPLICATION NUMBER: 22

b. STATUS OF ALL CLAIMS

CLAIMS 1-5, 7, 8 AND 10-22 ARE PENDING IN THE APPLICATION.

CLAIMS 1-5, 7, 8 AND 22 ARE REJECTED IN THE APPLICATION.

c. CLAIMS ON APPEAL

THE CLAIMS ON APPEAL ARE CLAIMS 1-5, 7, 8 AND 10-22.

IV. STATUS OF AMENDMENT (37 C.F.R. §1.192(c)(4))

Appellant submitted no amendments subsequent to the final rejection dated August 2, 2002.

V. SUMMARY OF THE INVENTION (37 C.F.R. §1.192(c)(5))

Applicant's invention is directed to a new and improved breast prosthesis and bust cup system and a breast prosthesis which has been and developed by Applicant as a result of her extended battle with breast cancer. A key and fundamental feature of Applicant's invention is the highly comfortable wear and fit afforded by the wearer of the breast prosthesis. This provided in large part by the comfort pad 20, 40 which is removably attached to the rear surface of the prosthesis 10 through the rear hook material. Applicant's invention is concerned with a prosthesis having an efficient construction which is comfortable for the wearer.

Figure 1 is a front view of the breast prosthesis 10 and is distinguished from the rear view shown in Figure 2 by inclusion of a nipple area 12 typically found in a breast

prosthesis. Hook material 1 is applied to the front surface of the breast prosthesis 10 near the edges of the prosthesis. As shown in Figure 1, the hook material 1 is a strip having a length greater than its width and is positioned along the periphery of the prosthesis. Figure 2 is a rear view of the prosthesis 10. The back edges of prosthesis 10 include hook material 1. As shown in Figure 2, the hook material 1 is a strip having a length greater than its width and is positioned along the periphery of the prosthesis.

Figure 3 is a rear view of a bust cup 30. Loop material 2 is attached (e.g., sewn) to the inside edges of bust cup 30 as shown in Figure 3. Loop material 2 is provided in two strips each having a length greater than its width and positioned along the periphery of the bust cup 30. The loop material 2 on the inside of the bust cup 30 is positioned to engage the hook material 1 on the front surface of prosthesis 10. Figure 4 is a front view of a comfort pad 20 which is placed against hook material 1 on back of prosthesis 10 (shown in Figure 2). The comfort pad 20 provides a detachable backing for the prosthesis which is made of moisture absorbing material that can easily be removed and laundered.

Figure 5 is an exploded cross-sectional view of the assembly of the present invention. The prosthesis 10 is placed in bust cup 30 so that hook material 1 on the front of prosthesis 10 engages loop material 2 on the inside of bust cup 30. The comfort pad 40 is placed against the rear of prosthesis 10 and is secured to the prosthesis 10 through hook material 1 on the rear of prosthesis 10. The rear surface of the prosthesis 10 and the comfort pad 40 each have a triangular shape with rounded corners.

The present invention provides an improvement by which a mastectomy prosthesis can be worn in a conventional bra or garments with bust cups rather than mastectomy bras and other pocketed type garments thereby enabling the wearer to appear more natural and to feel more comfortable and secure.

VI. ISSUES (37 C.F.R. §1.192(c)(6))

- (1) Whether claims 1-5, 7, 8, 10-17 and 21-22 are patentable under 35 U.S.C. §103(a) over Brickman U.S. Patent No. 3,161,200 in view of Eberl et al U.S. Patent No. 4,681,587.
- (2) Whether the features recited in claims 16-18 are an "obvious design choice".

- (3) Whether claims 19 and 20 are patentable under 35 U.S.C. §102(b) over Eberl et al U.S. Patent No. 4,681,587.

VII. GROUPING OF CLAIMS (37 C.F.R. §1.192(c)(7))

Claims 1-5, 7, 8, 20 and 21 stand together. *also depends from 15*

Claims 10-14 stand together.

Claims 15 and 16 stand together.

Claims 17 and 18 stand together.

Claim 19 stands alone.

Claim 22 stands alone.

VIII ARGUMENTS - REJECTIONS UNDER 35 U.S.C. §102(b) (37 C.F.R. §1.192 (c)(8)(ii))

Applicant notes the proper standard under 35 U.S.C. §102 for finding anticipation is that the prior art must disclose each and every limitation found in the claims, either expressly or inherently. Rockwell International Corp. v. United States, 147 F.3d 1358, 1363 (Fed. Cir. 1998); Electro Med System S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Furthermore, the omission of any claimed element no matter how insubstantial is grounds for traversing a rejection based on Section 102. Connell v. Sears Roebuck & Co., 772 F.2d 1542 (Fed. Cir. 1983).

The Examiner has erred in rejecting claims 19 and 20.

Claim 19 recites as follows:

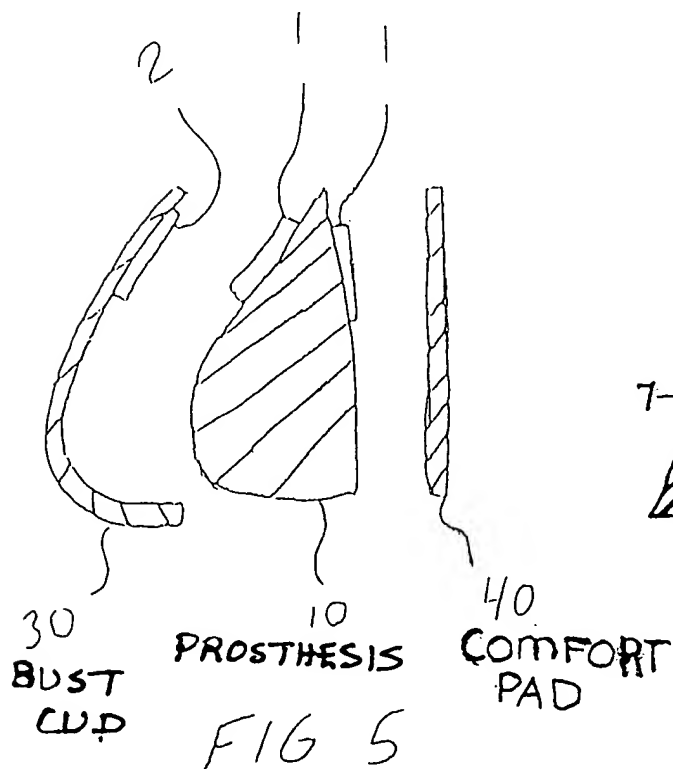
19. A breast prosthesis adapted for use by a wearer comprising:
a prosthesis having front surface and a rear surface, said rear surface being positionable adjacent to a wearer's body and having a first shape;
a comfort pad having a second shape generally congruent to said first shape; and
hook and loop means for removably attaching said comfort pad to said rear surface.

The Examiner has erred in rejecting claims 19-20 as being fully anticipated by Eberl et al U.S. Patent No. 4,681,587 for the reason that the Examiner improperly contends that Eberl teaches detachably coupling a comfort pad 3b to a breast prosthesis. The Examiner

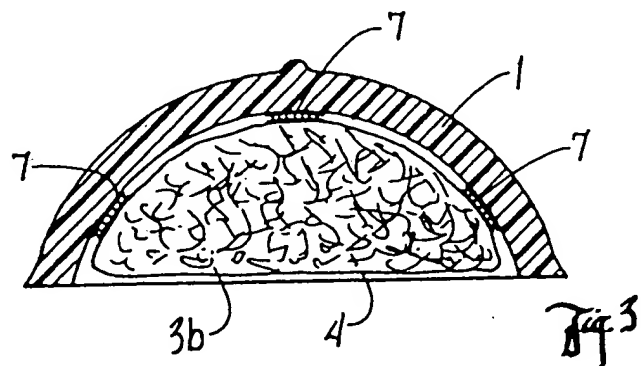
arbitrarily considers a pad member 3b of Eberl to be a comfort pad because, according to the Examiner, it reduces the weight of the prosthesis, making it more comfortable for the wearer, as constructed of material such as cotton, which is well-known for its breathability and softness for objects that are in contact with the skin, etc. (Final Rejection Page 2, Fourth Paragraph.)

The citation of the Examiner to 3b as a "comfort pad" is clearly not the comfort pad of Applicant's claimed invention. To the contrary, the structure 3b of the Eberl reference corresponds to Applicant's prosthesis and clearly does not correspond to the claimed comfort pad. Accordingly, Applicant respectfully submits that the rejection cannot be maintained.

The cited structure of Eberl Figure 3 and Applicant's Figure 5 annotated to illustrate the Examiner's position is illustrated below:



APPLICANT



EBERL ET AL
FIGURE 3

Not having a comfort pad, the examiner's conclusion that the Eberl comfort pad has a shape generally congruent to that of the rear surface also cannot stand.

The Examiner's rejection of claim 20 under §102(b) is clearly erroneous since the base claim 15 is only rejected under §103(a).

IX. ARGUMENTS - REJECTIONS UNDER 35 U.S.C. §103(a) (37 CFR §1.192(c)(8)(iv))

CLAIMS 1-5, 7, 8, 20 AND 21

The Examiner has erred in rejecting claims 1-5, 7, 8, 20 and 21. These claims stand rejected over Brickman U.S. Patent No. 3,161,200 in view of Eberl U.S. Patent No. 4,681,587

Claim 1 reads as follows:

1. A breast prosthesis and bust cup system adapted to be worn by a wearer comprising:
 - a breast prosthesis having a front surface and a rear surface, said rear surface being positionable adjacent to a wearer's body;
 - front hook material positioned on said front surface; rear hook material positioned on said rear surface;
 - a bust cup including loop material engagable with said hook material, wherein said breast prosthesis is receivable in said bust cup; and
 - a comfort pad attached to said rear surface through said rear hook material.

Nowhere in the Brickman reference is there any teaching of the need for a comfort pad in addition to a bust cup and a breast prosthesis receivable in the bust cup. The Examiner's alleged comfort pad 3b of Eberl is nothing more than the Eberl breast prosthesis. In short, the Examiner's position requires that one element be both the claimed prosthesis and the comfort pad which Applicant clearly teaches is to be a detachable backing for the prosthesis that can be easily removed and laundered (Application p. 3, ¶12-14).

In Corning Glass Works v. Sumitomo Electric, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989), the Federal Court of Appeals stated "[i]t is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim."; MPEP §2111.01:

"the words of a claim must be given their 'plain meaning' unless they are defined in the specification." and In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989): "[w]hen the Applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning . . .".

The comfort pad of Applicant's specification cannot be interpreted in a fashion that one could construe element 3b of Eberl as a comfort pad.

The Examiner has also erred in rejecting claims 1-5, 7 and 8 under 35 U.S.C. §103(a) over the Brickman and Eberl et al references not only because the proposed combination does not disclose, teach or suggest the "comfort pad", but the proosed combination also does not disclose, teach or suggest the manner of attachment as set forth in Applicant's claims. The Examiner has explicitly acknowledged at page 3, second paragraph and the last paragraph and page 4, second paragraph of the Final Action dated August 2, 2002, that the Brickman and Eberl et al references fail to disclose rear hook material positioned on the rear surface of the breast prosthesis. The Examiner further acknowledged in the Final Action at page 3 that Eberl et al is silent whether a hook or loop material fastener is attached to the rear of the prosthesis. The Examiner has, without basis, merely stated that "It would have been an obvious reversal of parts to have either and would have been obvious to one of ordinary skill in the art."

The courts have stated the Examiner cannot discharge himself from the burden of showing all the claimed elements by simply declaring all of the elements of an invention, along with the manner of combining these elements, to be well known in the art. Ex parte Stern, 13 USPQ2d 1379, 1381 (Bd. Pat. App. & Inter. 1989).

35 U.S.C. §103 specifies that the obviousness of an invention is to be determined as of "the time the invention was made." This requires the Examiner to step backward in time and into the shoes worn by the hypothetical person of ordinary skill in the art when the invention was unknown and just before it was made. See MPEP §2142. "When applying 35 U.S.C. 103, . . . the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention . . ." Hodosh v. Block Drug Co., Inc., 229 USPQ 182, 187, n5 (Fed. Cir. 1986); W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of

record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."); In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). (It is the prior art itself, and not the applicant's achievement that must establish the obviousness of the combination. Obviousness cannot be established by hindsight combination to produce the claimed invention.)

CLAIMS 10-14

Claim 10 recites as follows:

10. A breast prosthesis adapted for use by a wearer comprising:
a front surface and a rear surface, said rear surface being positionable adjacent to a wearer's body;
hook material positioned on said front surface;
rear hook material positioned on said rear surface; and
a comfort pad removably attached to said rear surface through said rear hook material.

Neither the Brickman reference nor the Eberl reference disclose, teach or suggest either individually or in combination a breast prosthesis having hook material position on the front surface and rear hook material position on the rear surface. For this reason alone, the Examiner's rejection of claims 10-14 is erroneous. Neither of the cited references suggest the need for connecting structures on both the front surface and the rear surface of the prosthesis.

CLAIMS 15 AND 16

The Examiner has also erred in rejecting claims 15 and 16. Representative claim 15 recites as follows:

15. The breast prosthesis and bust cup system of claim 1, wherein said rear surface of said breast prosthesis has a substantially triangular shape with rounded corners.

The Examiner has, in addition to the erroneous rejection of claim 1, failed to substantiate that the use of substantially triangular shape with rounded corners is an obvious matter of design choice. While the statement of the Examiner can be stated with respect to any shape in the abstract, the Examiner has failed to appreciate that the shape is ultimately in reference to the comfort pad which is an important feature of Applicant's invention which is specifically designed for comfort ease of wear especially for cancer patients who require prosthesis after surgery. The shape of the comfort pad functions to facilitate the comfort feature. The invention as claimed was developed by the Applicant from her own personal experience in order to provide a breast prosthesis which would afford the wearer comfort.

Products of a particular shape may be patentable over the prior art if the shape results in a product which is distinct from the reference product. Ex Parte Hilton, 148 USPQ 356 (Bd. App. 1965).

CLAIMS 17 AND 18

The Examiner has erred in rejecting claims 17 and 18. Representative claim 17 recites as follows:

17. The breast prosthesis and bust cup system of claim 1, wherein said comfort pad has a substantially triangular shape with rounded corners.

The Examiner has failed to remotely identify a comfort pad having such a shape.

CLAIM 22

Claim 22 recites as follows:

22. The breast prosthesis of claim 19, wherein said first and second shapes are generally triangular with rounded corners.

In addition to the errors of the Examiner in rejecting base claim 19, the Examiner has failed to cite any proper basis for the feature wherein both the first and second shapes

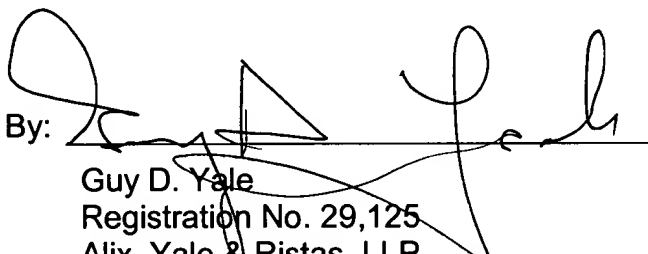
are generally triangular with rounded corners. Clearly, no such shapes are found in either the Brickman or Eberl references.

X. CONCLUSION

Claim 19 is patentable since the Eberl reference does not disclose the cited comfort pad. Claim 20 stands erroneously rejected under §102 since the base claim 15 has not been rejected under §102. Claims 1-5, 7, 8, and 10-22 are patentable because the proposed combination does not properly disclose, teach or suggest the claimed subject matter.

Respectfully Submitted,

Judith F. Miller

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XI. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. A breast prosthesis and bust cup system adapted to be worn by a wearer comprising:

a breast prosthesis having a front surface and a rear surface, said rear surface being positionable adjacent to a wearer's body;

front hook material positioned on said front surface; rear hook material positioned on said rear surface;

a bust cup including loop material engagable with said hook material, wherein said breast prosthesis is receivable in said bust cup; and

a comfort pad attached to said rear surface through said rear hook material.

2. The breast prosthesis and bust cup system of claim 1 wherein said hook material comprises two strips of hook material positioned along a periphery of the breast prosthesis.

3. The breast prosthesis and bust cup system of claim 2 wherein each of said strips has a length greater than its width.

4. The breast prosthesis and bust cup system of claim 2 wherein said loop material comprises two strips of loop material positioned along a periphery of the bust cup.

5. The breast prosthesis and bust cup system of claim 4 wherein each of said strips has a length greater than its width.

7. The breast prosthesis and bust cup system of claim 1 wherein said rear hook material comprises two strips of hook material positioned along a periphery of the breast prosthesis.

8. The breast prosthesis and bust cup system of claim 7 wherein each of said strips of rear hook material has a length greater than its width.

10. A breast prosthesis adapted for use by a wearer comprising:
 - a front surface and a rear surface, said rear surface being positionable adjacent to a wearer's body;
 - hook material positioned on said front surface;
 - rear hook material positioned on said rear surface; and
 - a comfort pad removably attached to said rear surface through said rear hook material.
11. The breast prosthesis of claim 10 wherein said hook material comprises two strips of hook material positioned along a periphery of the breast prosthesis.
12. The breast prosthesis of claim 11 wherein each of said strips has a length greater than its width.
13. The breast prosthesis of claim 10 wherein said rear hook material comprises two strips of hook material positioned along a periphery of the breast prosthesis.
14. The breast prosthesis of claim 13 wherein each of said strips of rear hook material has a length greater than its width.
15. The breast prosthesis and bust cup system of claim 1, wherein said rear surface of said breast prosthesis has a substantially triangular shape with rounded corners.
16. The breast prosthesis and bust cup system of claim 10, wherein said rear surface has a substantially triangular shape with rounded corners.
17. The breast prosthesis and bust cup system of claim 1, wherein said comfort pad has a substantially triangular shape with rounded corners.
18. The breast prosthesis and bust cup system of claim 10, wherein said comfort pad has a substantially triangular shape with rounded corners.

19. A breast prosthesis adapted for use by a wearer comprising:
a prosthesis having front surface and a rear surface, said rear surface being positionable adjacent to a wearer's body and having a first shape;
a comfort pad having a second shape generally congruent to said first shape; and
hook and loop means for removably attaching said comfort pad to said rear surface.
20. The breast prosthesis of claim 15 wherein said hook and loop means comprise two strips of hook material positioned along a periphery of the breast prosthesis.
21. The breast prosthesis of claim 20 wherein each of said strips has a length greater than its width.
22. The breast prosthesis of claim 19, wherein said first and second shapes are generally triangular with rounded corners.

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NOTICE OF APPEAL TRANSMITTAL FORM

First Named Inventor	Judith F. Miller
Title	Hook and Loop System for Attaching a Breast Form Prostheses to Garments with Built-In Cups
Serial No.	09/911,620
Filing Date	July 24, 2001
Examiner	Bruce Edward Snow
Group Art Unit	3738
Attorney Docket Number	MILJ/101/US
Date	April 30, 2003

Commissioner for Patents
United States Patent and
Trademark Office
Washington, DC 20231
Attention: Board of Patent Appeals
and Interferences

Honorable Sir:

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION - 37 C.F.R. § 1.192(a))

- 1) Transmitted herewith, in triplicate, is the Appeal Brief in this application with respect to the Notice of Appeal filed on January 31, 2003.

- 2) STATUS OF APPLICANT: This application is on behalf of:

☐ Large Entity
☒ Small Entity

- 3) FEE FOR FILING APPEAL BRIEF

PURSUANT TO 37 C.F.R. §1.17(c), the fee for filing the Appeal Brief is:

☐ Large Entity \$320.00
☒ Small Entity \$160.00

- 4) EXTENSION OF TIME

It is hereby petitioned that any required extension of time be granted for filing the Appeal Brief. An extension of 1 month(s) having a fee of \$ 55.00 appears required.

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited on the date below with the United States Postal Service as first class mail in an envelope addressed to "Commissioner for Patents, United States Patent and Trademark Office, Washington, DC 20231."

Typed or Printed Name Guy D. Yale

Reg. No. 29,125

Signature [Signature]

Date: April 30, 2003

First Named Inventor Judith F. Miller	Title Hook and Loop System for Attaching a Breast Form Prostheses to Garments with Built-In Cups	Attorney Docket Number MILJ/101/US
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5) TOTAL FEE DUE

APPEAL BRIEF DUE: \$ 160.00

EXTENSION FEE DUE: \$ 55.00

TOTAL FEE DUE: \$ 215.00

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6) FEE PAYMENT

☒ Attached is a check in the amount of: \$ 215.00

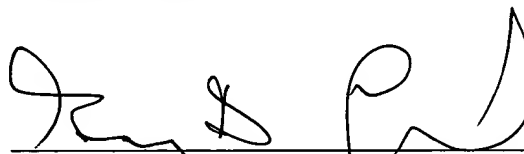
7) FEE DEFICIENCY

☒ If any additional extension and/or fee is required, this is a request therefor and the Commissioner is authorized to charge Deposit Account No. 16-2563, and/or if there is any overpayment, the Commissioner is authorized to credit any overpayment to Deposit Account No. 16-2563. A duplicate copy of this sheet is enclosed.

Respectfully Submitted,

Judith F. Miller

By:



Guy D. Yale
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SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or
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Signature

Date

April 30, 2003

Attorney's Docket No.

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